The remand being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MISUO SUGIYAMA et al.

Appeal No. 2002-0968
Application No. 08/960,431[1]

REMAND TO EXAMINER

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, and NASE, Administrative Patent Judge.

Per curiam.

REMAND TO THE EXAMINER

The above-identified application is being remanded to the examiner for appropriate action.

[1] Application filed October 29, 1997, for reissue of U.S. Patent No. 5,605,499 (Application No. 08/421,706, filed April 13, 1995).

BACKGROUND

1. A review of the file record indicates that claims 1 to 13 have been rejected under 35 U.S.C. § 251 as attempting to recapture subject matter surrendered in the application to obtain the original patent.

2. A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was decided May 29, 2003 in Ex parte Eggert.[2] In Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the "surrendered subject matter" was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the "recapture rule." Slip. op. at 39-45.

ACTION

We remand this application to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.

If the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner's answer specifically addressing the § 251 rejection. See 37 CFR § 1.193(b)(1). In the event

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[2] A copy of the Eggert opinion is attached to this opinion. An electronic copy of Eggert is available at http://www.uspto.gov/web/offices/dcom/bpai/prec/RC010790.pdf.

that the examiner furnishes a supplemental answer, the appellant may file a reply brief in accordance with 37 CFR § 1.193(b)(1).

If the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.

CONCLUSION

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

BRUCE H. STONER, JR.
Chief Administrative Patent Judge

GARY V. HARKCOM
Vice Chief Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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